



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,787	10/27/2000	Victor Levy	50824-2-2-1	6687

7590 06/07/2004

VITA CONFORTI
Davis Wright Tremaine LLP
2600 Century Square
1501 Fourth Avenue
Seattle, WA 98101-1688

EXAMINER

PASS, NATALIE

ART UNIT PAPER NUMBER

3626

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,787

Applicant(s)

LEVY, VICTOR

Examiner

Natalie A. Pass

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-7 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4 and 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 27 October 2000. Claims 1-7 are pending.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-5, drawn to a process and apparatus for facilitating patient self-diagnosis, classified in class 705, subclass 2.
 - II. Claim 6, drawn to a process for designing an algorithm, classified in class 702, subclass 181.
 - III. Claim 7, drawn to a process for determining a diagnosis, classified in class 706, subclass 46.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as health care management and invention II has separate utility such as a measurement system with probability determination and invention III has separate utility such as creation and maintenance of expert systems. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I)

5. During a telephone conversation with Bruce Kaser on May 4, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites "an apparatus or server system" in the preamble. As such it is unclear whether applicant seeks patent protection for an apparatus or for a server system. Please note MPEP section 2106. For the purpose of finding art, Examiner interprets the claim to recite a server system.

Claim Rejections - 35 USC §101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

9. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-4 only recite abstract ideas. The recited claims detailing the steps of providing entry points or symptoms, providing disease categories, and reporting possible diagnoses do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute different parts of a process for facilitating patient self-diagnosis of symptoms.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a series of possible diagnoses (i.e., repeatable) that can be used in assisting self-diagnosis of medical symptoms (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-4 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haessler et al., U.S. Patent Number 4, 130, 881 in view of Iliff et al., U.S. Patent Number 6, 206, 829.

(A) As per claim 1, Haessler teaches a process for facilitating patient self-diagnosis of symptoms comprising the steps:

(a) providing a plurality of entry points that are symptoms that the patient will indicate are present (Haessler; see at least Figure 4, Figure 5, Figure 6, column 1, line 45 to column 2, line 39, column 3, line 29 to column 4, line 39, column 4, line 60 to column 5, line 6); and

(b) providing a plurality of disease categories or symptomatic areas that the patient will check are related to the symptoms indicated in step a (Haessler; see at least Figure 3, column 4, lines 14-39).

Although Haessler teaches a medical correlation (Haessler; column 2, lines 24-39), Haessler fails to explicitly disclose

(c) reporting a series of possible diagnoses and probabilities of such diagnoses.

Art Unit: 3626

However, the above features are well-known in the art, as evidenced by Iliff.

In particular, Iliff teaches

(c) reporting a series of possible diagnoses and probabilities of such diagnoses (Iliff; column 12, lines 34-51, column 39, line 66 to column 40, line 63, column 41, lines 39-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Haessler to include reporting a series of possible diagnoses and probabilities of such diagnoses, as taught by Iliff, with the motivations of providing a medical knowledge-based system designed to give medical diagnostic and treatment advice to the general public which is extremely fast and offers virtually unlimited access to health care information, twenty-four hours a day and providing up-to-date medical advice for the most commonly encountered problems in general practice and emergency medicine, and providing medical advice particular to a medical condition to individual patients (Iliff; column 3, line 42 to column 5, line 6).

(B) As per claims 2, 4, Haessler and Iliff teach a process as analyzed and discussed in claim 1 above

wherein each diagnosis is linked to a series of warnings if a possible disease requires urgent or immediate treatment (Iliff; column 25, line 55 to column 26, line 34, column 35, line 61 to column 36, line 49, column 41, lines 23-37); and

wherein the process further comprises a step to provide any information of medications being taken, wherein possible side effects can be linked to the medications (Iliff; column 13, lines 5-20, column 24, line 61 to column 25, line 16).

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haessler et al., U.S. Patent Number 4, 130, 881 and Iliff et al., U.S. Patent Number 6, 206, 829 as applied to claim 1 above, and further in view of Altman et al., U.S. Patent Number 5, 572, 421.

(C) As per claim 3, Haessler and Iliff teach a process as analyzed and discussed in claim 1 above.

Haessler and Iliff fail to explicitly disclose a process wherein each diagnosis is linked to a disclaimer statement.

However, the above features are well-known in the art, as evidenced by Altman.

In particular, Altman teaches a process wherein each diagnosis is linked to a disclaimer statement (Altman; column 16, lines 55-59, Appendix I, column 37-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Haessler and Iliff to include wherein each diagnosis is linked to a disclaimer statement, as taught by Altman, with the motivations of limiting liability of the automated data collection, calculation of numerical measures, and diagnostic process (Altman; column 2, lines 41-54).

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Iliff et al., U.S. Patent Number 6, 206, 829.

(A) Claim 5 differs from claim 1 in that it is an apparatus or server system for implementing a patient self-diagnosis service rather than a process for facilitating patient self-diagnosis of symptoms.

As per claim 5, Iliff teaches an apparatus or server system for implementing a patient self-diagnosis service over a wide area network means of communication (Iliff; see at least Abstract, column 4, lines 46-58), wherein the server system comprises a central processing unit, ROM, RAM, and a data storage device (Iliff; column 7, line 29 to column 8, line 44), wherein the data storage device comprises one or a plurality of databases selected from the group consisting of a symptoms database, a disease category database, a medications database, a diseases database, a health insurers/systems database, a health care professionals database, and combinations thereof, wherein the symptoms database, the disease category database, and the diseases database must be present (Iliff; Figure 6, column 8, lines 25-41, column 21, line 10 to column 25, line 17, column 35, line 41 to column 38, line 56, column 52, lines 27-34, column 60, lines 56-67, column 67, lines 18-20, column 68, lines 6-47).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references Sloane, U.S. Patent Number 5, 911, 132,

Art Unit: 3626

Hendrickson, U.S. Patent Number 5, 404, 292 and the article teach the environment of computer aided diagnosis of medical symptoms.

Sloane, U.S. Patent Number 5, 911, 132, teaches diagnosis of disease using databases and communications.

Hendrickson, U.S. Patent Number 5, 404, 292, teaches a data processing system and method for automatically performing prioritized nursing diagnoses from patient assessment data utilizing diagnosis tables.

Ingram, R. Accounting Information Systems. 1998. Culverhouse School of Accountancy. University of Alabama. [Retrieved on June 1, 2004]. Retrieved from the Internet. URL<<http://www.cba.ua.edu/accounting/ingram/Accounting%20Information%20Systems.doc>>.

16. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(703) 305-7687.**

For informal or draft communications, please
label "PROPOSED" or "DRAFT" on the front page of
the communication and do NOT sign the
communication.

Art Unit: 3626

After Final communications should be labeled

"Box AF."

Hand-delivered responses should be brought to Crystal

Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor

(Receptionist).


17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.



Natalie A. Pass

June 1, 2004


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600